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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,006	02/25/2004	Pier Antonio Guarda	108910-00125	9739

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EXAMINER

HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,006

Applicant(s)

GUARDA ET AL.

Examiner

Henry S. Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment of February 25, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that **Pre-Amendment** filed on February 25, 2004 was received. **Claims 3, 5-6 and 10-14 were only amended to delete the improper multiple claim dependency.** It is noted also that USPTO has received two **IDS'** filed on May 25 and July 23, 2004 respectively. **Claims 1-14** with one independent claim (Claim 1) are now pending. An action follows.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. **Claims 1-7**, drawn to **a linear type compound perfluoropolyether** having a specific formula (I) as $T-O-(CF_2O)_n(CF_2CF_2O)_m(CF_2CF_2CF_2O)_r(CF_2CF_2CF_2CF_2O)_s-T_1$, classified in class 526, subclass 247.

II. **Claim 8-12**, drawn to **a process of making a linear type compound perfluoropolyether** having formula (I) as $T-(CF_2O)_n(CF_2CF_2O)_m(CF_2CF_2CF_2O)_r(CF_2CF_2CF_2CF_2O)_s-T_1$ through peroxidic and then fluorination route, classified in class 525, subclass 387.

III. **Claims 13-14**, drawn to **the use of a linear type compound perfluoropolyether** having formula (I) as $T-O-(CF_2O)_n(CF_2CF_2O)_m(CF_2CF_2CF_2O)_r(CF_2CF_2CF_2CF_2O)_s-T_1$ as lubricants, classified in class 428, subclass 421.

3. The inventions are distinct, each from the others because of the following reasons:

Inventions II and I are related as process of making and product made, while **Inventions I and III** are related to a product and its process of using. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

4. In a close examination, the process of making in Group II involves **the specific peroxidic and then fluorination route**. In the instant case the process as claimed can be used to make other and materially different organic or polymeric compounds, the requirement is that the such a starting compound needs to contain the same type of claimed reactive end group(s) so as to react with perfluoropolyether oil.

5. **Linear type compound of perfluoropolyether of Group I can be prepared by some way, which is other than using the process of Group II.** For instance, without using a reactive peroxidic and fluorination route (see prior art cited on page 3 of specification). The process of making is unique and thereby not interchangeable.

In other close examination, the process of using in Group III involves **the specific use as a lubricant**. In the instant case the process as claimed can be used for other purpose other than lubrication. For instance, it can be used as a reaction medium or as a solvent. The

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requirement is that such a linear type **compound** perfluoropolyether will not be reacted with others. Therefore, the scope of the claims, i.e., the metes and boundaries are distinct. It is noted that **the use claims (Claims 13-14) are improper according to MPEP since steps and/or sequence of using are NOT disclosed.**

6. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that no phone call was made to **Richard J. Berman (registration # 39,107, tel: 202 857-6000)** by the examiner due to the complexity on multiple **(three)** groups.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu** whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

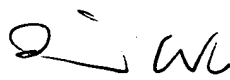
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

March 8, 2006



DAVID W. WU
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